

Appln. Serial No. 10/066,097
Amendment Dated November 16, 2007
Reply to Office Action Mailed August 22, 2007

REMARKS

In the Office Action dated August 22, 2007, claims 1, 3-10, and 21-26 were rejected under 35 U.S.C. § 112, ¶ 2; claims 1, 3-11, 13-16, and 18-28 were rejected under 35 U.S.C. § 103(a) as unpatentable over www.google.com (web.archive.org dated January 19, 2001) (hereinafter "Google document"); claims 11, 13-16, and 18-28 were rejected under 35 U.S.C. § 103(a) as unpatentable over Applicant Admitted Prior Art (AAPA) in view of US. Patent No. 5,960,173 (Tang).

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REJECTION UNDER 35 U.S.C. § 112, ¶ 2

Claim 1 has been amended to address the § 112, ¶ 2 rejection, by deleting "publication and" in the first line of claim 1. Therefore, the § 112, ¶ 2 rejection has been overcome.

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REJECTION UNDER 35 U.S.C. § 103(a)

Independent claim 1 was rejected as being obvious over the Google document. It is respectfully submitted that the rejection is erroneous as the Office Action has committed both legal error and factual error in making the rejection. Note that Applicant has amended claim 1 to improve its form. This amendment does not change the scope of claim 1 from the previous version of claim 1.

The Office Action considered much of claim 1 as being entitled to "no patentable weight," and has effectively rewritten claim 1 to delete most of the words in claim 1. See 8/22/2007 Office Action at 6. This constitutes clear legal error. The case law is emphatically clear that "[a]ll words in a claim must be considered in judging the patentability of that claim against prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494 (CCPA 1970). The words that the Office Action has deleted from claim 1 are not words found in the preamble for an intended field of use. In fact, the words deleted by the Office Action are words that appear in the body of claim 1, and are part of the specific tasks recited in claim 1.

Therefore, the position of the Office Action that most of the language of claim 1 constitutes intent to use language is clearly incorrect. The words ignored by the Office Action are words found in specific tasks of claim 1, and clearly do not constitute intent to use language.

The Office Action also asserted that since the "claimed invention is generally about 'data processing' then the term 'e-services' merely refers to the function or 'name' of the information or data stored in a database, i.e. the data is about 'e-service of a organization'." 8/22/2007 Office Action at 4. The Office Action then took the position that the "function or name or intended use of the data is considered as 'non-functional' descriptive material and receive no patentable weight." *Id.* This position is clearly erroneous. The term "e-services" and other like terms in claim 1, such as "e-service descriptions," "service provider organizations," and so forth, should be construed according to what a person of ordinary skill in the art would have understood such terms to mean. The position in the Office Action that such terms are given no patentable weight constitutes clear legal error. The terms are well supported throughout the Specification of the present application. Based on the ordinary meaning of the claim terms themselves, as well as based on the teachings of the Specification, a person of ordinary skill in the art would clearly

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have understood that terms such as "e-services," "e-service descriptions," and "service provider organizations" have specific meanings.

When properly construed, the claimed subject matter is clearly different from the subject matter of the Google document. Claim 1 recites a discovery agent finding one or more prospective e-services based on one or more search parameters, where the e-services are published by corresponding service provider organizations in respective e-service descriptions, and where finding the one or more prospective e-services includes matching the one or more search parameters with the published e-service descriptions.

The Google document merely discusses a SiteSearch or a WebSearch feature – there is no hint anywhere in the Google document of matching one or more search parameters with published e-service descriptions by service provider organizations for e-services to find one or more prospective e-services.

According to the Google document, the custom WebSearch feature provided by Google allows for Internet search "on your portal or destination site." Google Document, at 3. Moreover, the WebSearch feature "enables your site visitors to search the Internet." *Id.* "With Google, your site visitors can search over one billion pages of the Internet." *Id.* As further described on page 5 of the Google document, the WebSearch feature is a "hosted solution that allows your visitors to conduct web and specialty searches on your site, with the results provided within your own template." *Id.* at 5.

The SiteSearch feature "enables your site visitors to search just your site" *Id.* at 3. The SiteSearch feature is a "fully customized way for users to search just your site." *Id.* The SiteSearch feature is also a "hosted solution that allows your visitors to conduct web and specialty searches on your site" *Id.* at 9.

Basically, the Google document describes features provided by the Google search engine that allow a provider of a website to incorporate a search feature (either the WebSearch feature or the SiteSearch feature) onto the provider's website to allow for web searching.

However, neither the WebSearch nor SiteSearch feature of the Google document provides the following feature of claim 1: finding one or more prospective e-services based on one or more search parameters, wherein e-services are published by corresponding service provider organizations in respective e-service descriptions, and wherein finding the one or more

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prospective e-services comprises matching the one or more search parameters with the published e-service descriptions.

Since the obviousness rejection is based on the incorrect legal basis of ignoring many of the words of the claim, it is respectfully submitted that the Office Action has failed to establish a *prima facie* case of obviousness with respect to claim 1. Moreover, the Office Action has provided no rationale or evidence that features of claim 1 not found in the Google document would have been known to a person of ordinary skill in the art in the context of the claimed invention.

In view of the foregoing, a *prima facie* case of obviousness has not been established with respect to claim 1. Independent claim 11 is also similarly allowable over the Google document.

Dependent claims of claims 1 and 11 are allowable for at least the same reasons as corresponding independent claims.

Moreover, the Office Action incorrectly asserted that features of certain of the dependent claims are "inherently" included in the Google document. It is respectfully submitted that a rejection based on inherency has not been properly established.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" M.P.E.P. § 2112 (8th ed., Rev. 6), at 2100-47. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Id.*, at 2100-48. Here, the Office Action has provided no rationale or evidence regarding why the terms of the dependent claims would be inherently found in the Google document. For example, claim 21 recites that matching the one or more search parameters with the published e-service descriptions comprises matching the one or more search parameters that contain at least price and quantity parameters. The Office Action stated that this feature is "inherently included or fairly taught on pages 6-11 of [the Google document]." Nowhere on pages 6-11 is there any hint of search parameters that contain at least price and quantity parameters that can be matched with published e-service descriptions.

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Claim 22 recites "matching the one or more search parameters with the published e-service descriptions that describe Internet-delivered commercial services." Again, the Google document does not describe published e-service descriptions that describe Internet-delivered commercial services. The Office Action has failed to establish why such published e-service descriptions that describe Internet-delivered commercial services would necessarily be part of the Google document.

Claim 23 recites "matching the one or more search parameters using fuzzy matching logic in the discovery agent." Again, nowhere in the Google document is there any teaching of using fuzzy matching logic to perform the matching. Moreover, the Office Action has not established why the features of claim 23 would be necessarily present in the Google document.

Similar arguments are applicable to dependent claim 24.

Independent claim 11 was also rejected as being obvious over AAPA and Tang (or vice versa). It is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 11 for at least the following reasons: (1) no reason existed that would have prompted a person of ordinary skill in the art to combine the teachings of AAPA and Tang (*see KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2d 1385 (2007)); and (2) the hypothetical combination of AAPA and Tang would result in subject matter that is significantly different from the claimed subject matter.

Note that AAPA refers to the requirement that a service provider must register with centralized registries before the service provider's services can be made available to clients. As noted by the AAPA, the registration may involve a fee collected by the registry and may involve a burden on the service provider. Also, the AAPA notes that the exposure of the services to customers may be limited.

The registration requirement of the AAPA is contrasted with the subject matter of claim 11, where a discovery agent is executable to access e-service descriptions published at web servers of corresponding service providers. The publication of e-service descriptions that can be matched to one or more search parameters, as recited in claim 11, avoids the need to perform centralized registration as taught by the AAPA.

The registration requirement of the AAPA is also completely unrelated to the teachings of Tang, which describe a mechanism that "enables workers using their computers to know

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which other workers are 'nearby' in terms of the type of work they are doing, such as the data they are accessing, the application they are using, and the time when such work was performed." Tang, 3:23-28. The mechanism of Tang attempts to find a worker that is "task proximate" to another worker when both are accessing similar types of data, or using similar application tools within a particular time period. *Id.*, 3:29-33. The solution offered by Tang in finding task proximate workers would not have led a person of ordinary skill in the art to solve the problem of avoiding central registration of services, as described in the AAPA. In fact, the teachings of Tang are completely unrelated to the concerns raised by the AAPA.

Moreover, the hypothetical combination of AAPA and Tang would not have led to the claimed invention. The AAPA teaches that conventional techniques employ a central registry, which is contradictory to the claimed subject matter, where e-service descriptions are published at web servers of corresponding service providers. Tang, on the other hand, describes the ability to monitor information of multiple workers to find which workers are "task proximate." This teaching of Tang would not have led to the claimed feature of accessing e-service descriptions published at web servers of corresponding service providers, where the e-service descriptions describe respective Internet-based commercial services provided by corresponding service providers, and matching the received one or more search parameters with the e-service descriptions to identify one or more e-services satisfying the one or more search parameters.

Since the hypothetical combination of Tang and AAPA would have resulted in subject matter that is significantly different from the claimed invention, the *prima facie* case of obviousness is defective for this further reason.

The Office Action also made the following conclusion: "Alternatively, it would have been obvious to modify the teachings of TANG et al to include other types of information or organization entities such as e-service information as mere [sic] applying to other similar publication and discovery communication service using the same applications and web services." 8/22/2007 Office Action at 9. This conclusion is unsupported by any actual evidence or finding. Therefore, the alternative basis for the obviousness rejection is also inadequate.


Dependent claims of claim 11 are allowable for at least the same reasons as claim 11.

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In view of the foregoing, all claims are in condition for allowance, which action is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 08-2025 (10007908-1).

Respectfully submitted,

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